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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,485	05/06/2005	El Hassane Larhrib	N1518-WPT-EAS	2351
23456 7590 02/20/2008 WADDEY & PATTERSON, P.C. 1600 DIVISION STREET, SUITE 500 NASHVILLE, TN 37203			EXAMINER GEORGE, KONATA M	
			ART UNIT 1616	PAPER NUMBER
			MAIL DATE 02/20/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/501,485	Applicant(s) LARHRIB ET AL.	
	Examiner KONATA M. GEORGE	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 11, 21 and 24 is/are rejected.
- 7) ☒ Claim(s) 1-23 and 25 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of: .
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/8/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claims 1-25 are pending in this application.

Drawings

The drawing(s) filed under 37 CFR 1.184 or 1.152 are accepted by the examiner.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on October 8, 2004 was noted and the submission is in compliance with the provisions of 37 CFR 1.97.

Accordingly, the examiner has considered the information disclosure statement.

Claim Objections

Claims 1-23 and 25 are objected to because of the following informalities: For claims 1-23 please put "A" at the beginning of the claims. For claim 25, please put "An" in front of the claim. Appropriate correction is required.

Claims 6-10 and 12-25 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from another multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 6-10 and 12-15 have not been further treated on the merits with respect to the application of art against the claims. They will be rejected if necessary for formatting problems.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants in the claims recite the phrase "derivatives". Webster's Dictionary defines a derivative as "a substance derived from, or of such composition and properties, that it may be considered as derived from, another substance by chemical change, esp. by the substitution of one or more elements or radicals". Based on this definition it is unclear what the derivative is.

Claim 24 provides for the use of the hollow microporous particles, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 24 is directed to a non-statutory class of invention.

Claim 24 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gombotz et al. (hereafter Gombotz) (WO 90/13780).

Applicant claims a method of producing hollow microporous particles comprising a composition containing one active principle and at least one expansion agent, followed by cooling the composition and wherein all or part said at least one expansion agent is removed.

Determination of the scope and content of the prior art

(MPEP §2141.01)

Gombotz discloses on page 4, lines 4-26 a method of making a particle comprising dissolving a polymer/active agent into a solvent to form microparticles. The microparticles placed into a vessel containing a non-solvent and are cooled below the freezing point of the solution. Upon the thawing of the solution the solvent is slowly extracted into a non-solvent, resulting hardening microspheres. Page 9, table 1, teaches that the solvent can be acetone.

Ascertainment of the difference between the prior art and the claims

(MPEP §2141.02)

Gombotz does not teach the expansion coefficient or that the expansion agent is on selected from carbon dioxide, nitrogen, carbonate, etc.

Finding of prima facie obviousness

Rational and Motivation (MPEP §2142-2143)

It is the position of the examiner that since the prior art reference of Gombotz teaches a method of producing hollow porous particles with an expansion agent as claimed by applicant, the expansion coefficient would have been obvious. With respect to the specific expansion agent, the determination of the agent would have been made through routine experimentation to achieve the desired results of the claimed invention. This is in the absence of any clear showing of unexpected results attributable to the specific expansion agents employed by applicant in the instant case.

Conclusion

Claims 1-5, 11, 21 and 24 are rejected.

Telephone Inquiries

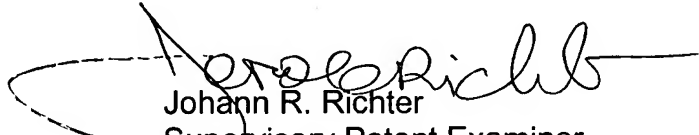
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is 571-272-0613. The examiner can normally be reached from 8:00AM to 6:30PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter, can be reached at 571-272-0646. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have question on access to the Private Pair system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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